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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,269	01/30/2004	Kurt-Robert Kappeler	010751-069	4842

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

MAIL DATE	DELIVERY MODE
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01/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/767,269

Applicant(s)

KAPPELER, KURT-ROBERT

Examiner

Walter B. Aughenbaugh

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1, 3-14, 19 and 20.
Claim(s) withdrawn from consideration: 15-18.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER

1/16/07

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The After Final Amendment filed December 11, 2006 has not been entered since the incorporation of the limitation of dependent claim 14 into independent claim 1 raises new issues that require further consideration and search because each of the dependent claims (other than claim 14) did not require the limitation of claim 14 prior to the After Final Amendment.

Response to Arguments

2. Applicant's arguments presented on pages 6-7 of the After Final Amendment regarding the 35 U.S.C. 102 rejection of claims 1, 3, 4, 19 and 20 have been fully considered but are not persuasive.

The recitations "the at least one marking section comprises a date or a production number" of claim 19 and "the at least one marking section indicates a material" of claim 20 are intended use phrases because the actual characters that constitute the marking section vary depending on what the user intends the characters to indicate, as is made clear from the recitations of claims 19 and 20. The actual characters that constitute the marking section vary depending on what the user intends the characters to indicate, as is made clear from the recitations of claims 19 and 20. The relevance of Applicant's statement that "the material that a given hose is made from does not change when that hose is used for different uses" is not explained by Applicant, and this statement is also unsupported: the composition of the hose is not limited to a single composition in claim 1.

3. Applicant's argument presented on page 7 of the After Final Amendment regarding the 35 U.S.C. 103 rejection of claim 5 has been fully considered but are not persuasive. Applicant's

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argument depends upon the entry of the After Final Amendment, which has not been entered for the reasons provided above in this Advisory Action.

4. Applicant's arguments presented on pages 7-10 of the After Final Amendment regarding the 35 U.S.C. 103 rejection of claim 14 have been fully considered but are not persuasive.

Applicant argues that "Stone does not suggest that the marker bands include characters and/or numbers that provide information about any characteristic of the sheath", but claim 14 does not require that the marking sections "provide information about any characteristic of the sheath". The marking section taught by Stone et al. (radiopaque marker, col. 5, lines 43-50) comprises a character since any marking is a character because a character is a graphic symbol used in writing or printing as evidenced by definition 1b of Merriam-Webster Online Dictionary. Paragraph 7 of previous Office Action mailed August 9, 2006. Applicant argues that a band is not a character, but a band is a character because it is a graphic symbol used in writing or printing. The words "as a" in definition 1b do not require that a character is a hieroglyph or alphabet letter as Applicant suggests. A band, which, in one form, may reasonably be considered to be a line segment, is no different from, for example, a lower-case "l" in the font Applicant has used in print in Applicant's arguments in the After Final Amendment. Applicant states that "the Office Action provides no basis for the assertion that Stone's 'bands' are necessarily a 'character'", but the Office Action need not show that the only possible embodiment of the bands of Stone is an embodiment where the bands are characters. A band, which, in one form, may reasonably be considered to be a line segment, is no different from, for example, a lower-case "l" in the font Applicant has used in print in Applicant's arguments in the After Final Amendment.

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Furthermore, text and numbers fall within the scope of the teaching of “markers” at col. 5, line 44 of Stone et al.

Applicant’s arguments in the first paragraph on page 9 of the After Final Amendment do not take into account the 35 U.S.C. 103 rejection of claim 14 of record. The recitation “recurring mode of arrangement” is recited in claim 14.

In regard to Applicant’s arguments in the second paragraph on page 9 of the After Final Amendment, the bands of Stone are characters for the reasons discussed above, Carden need not disclose or suggest that the bands are in the form of a character and/or number.

Applicant’s statements in the paragraph bridging pages 9 and 10 of the After Final Amendment address each of the references relied upon in the 35 U.S.C. 103 rejection of claim 14 in a piecemeal fashion, and an argument is not presented in this paragraph. Applicant seems to have intended to argue that there is no motivation to combine the references (although there can be no certainty that Applicant intended to argue that there is no motivation to combine the references from the language of Applicant’s arguments in the paragraph bridging pages 9 and 10), but since no convincing reasoning is presented as to how there is no motivation to combine the references, the rejection is maintained. The motivation to combine the references is clear from the rejection of record: both references pertain to radiopaque markers for medical devices that are implantable in the body, where the markers are used to assist the healthcare worker in positioning the devices within the body.

5. Applicant’s argument presented on pages 10-11 of the After Final Amendment regarding the 35 U.S.C. 103 rejections of claims 7-13 have been fully considered but are not persuasive.

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Applicant's arguments depend upon the entry of the After Final Amendment, which has not been entered for the reasons provided above in this Advisory Action.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter B. Aughenbaugh
01/10/07


JENNIFER R. MCNEIL
SUPERVISOR EXAMINER
1/16/07